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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,479	06/29/2001	Dominique Gougeon	10015734-1	5292

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Intellectual Property Administration
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EXAMINER

LIPMAN, JACOB

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,479

Applicant(s)

GOUGEON, DOMINIQUE

Examiner

Jacob Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because the word tool is misspelled in the third line.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation "downloading of the clear file into the terminal", when it is previously stated that the random number generator is included in the terminal. It is unclear where the random number is being downloaded from, and how it got there.
4. Claim 4 recites the limitation "the digitally signed file". There is insufficient antecedent basis for this limitation in the claim.
5. Claim 4 recites the limitation "a private key". It's unclear as to if this is the same private key previously disclosed in claim 2, or a new one.
6. Claim 8 recites the limitation "said smartcard". There is insufficient antecedent basis for this limitation in the claim.
7. Claim 8 recites the limitation "said digital signature". There is insufficient antecedent basis for this limitation in the claim.

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8. Claim 10 recites the limitation "downloading the digitally signed clear file to the terminal" when it is previously stated that the random number is stored in the terminal, and signed to create the digitally signed clear file. It is unclear where the digitally signed clear file is being downloaded from, and how it got there.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The stated result of restoring a terminal to a default condition is not met in these first two claims. For the sake of this office action will treat claims 1-3 as one claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-5, 7-13, 15, and 16, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Holt, US Patent number 6,404,862.

With regard to claims 1-3, Holt discloses A system for restoring a terminal to a default condition (logging in a user), including generating a random number (column 2

lines 57-59), and downloads a file including the random number (column 2 lines 62-64), where the terminal includes a public key (column 2 lines 65-67) to decrypt the private key encrypted random number (column 2 lines 60-62), and authenticates the file (column 2 line 67-column 3 line2).

With regard to claim 4, Holt discloses that the public key is used to decrypt the signed file (column 2 lines 60-67).

With regard to claims 5, 8, and 9, Holt discloses the private key is stored in a smartcard (column 2 lines 60-62).

With regard to claim 7, Holt discloses the smartcard is read with a smartcard reader (column 2 lines 59-63).

With regard to claim 10, 12, 13, 15, and 16, Holt discloses generating a random number for each challenge (column 2 lines 57-59).

With regard to claim 11, Holt discloses the number could be displayed and input, although it is not preferable (column 1 lines 14-49).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 6, 14, and 17, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordenstam, US Patent number 6,711,263, in view of Holt.

With regard to claims 6 and 14, Holt discloses the system as outlined above, but does not mention storing the private key in ROM. The examiner takes official notice that keys are frequently stored in ROM. It would have been obvious to one of ordinary skill in the art to store the keys in ROM lower the risk of key loss or manipulation.

With regard to claims 6 and 14, Holt discloses the system as outlined above, but does not mention authentication to delete certificates. Nordenstam discloses a system using a terminal, telephone, and smartcard (column 9 line 64-column 10 line6), in that an entity should be authenticated before being allowed to delete a certificate (column 9 lines 12-26). It would have been obvious to one of ordinary skill in the art to use Holt's authenticating technique in Nordenstam's system for Holt's given motivation of ease of user authentication (Holt, column 1 lines 36-40).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 571-272-3738. The examiner can normally be reached on 7:00 - 4:00 (M-Th).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL


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